

RECEIVED
CENTRAL FAX CENTER

JUN 21 2004

FAX COVER SHEET

NORRIS, McLAUGHLIN & MARCUS, P.A.
220 EAST 42ND STREET
30TH FLOOR
NEW YORK, NY 10017
212-808-0700
Fax 212-808-0844
tagottlieb@nmmlaw.com

SPECIAL

Total pages, including cover: 9

Send to:	United States Patent and Trademark Office
Attention:	L. Channavajjala
Art Unit :	1615
Fax Number:	703-872-9306

RESPONSE TO NON-FINAL ACTION**Comments:**

Transmitted herewith on 24 June 2004:

- Response and amendment -- 8 sheets

RECEIVED
CENTRAL FAX CENTER

Attorney Docket: 101216-19
USSN 09/975,520

JUN 24 2004

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO.	:	09/975,520
APPLICANT	:	Bettina FATH, et al.,
FILED	:	October 11, 2001
EXAMINER	:	L. Channavajjala
ART UNIT	:	1615
FOR	:	Composition for the Treatment of Human Hair

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

24 June 2004

RESPONSE 37 CFR § 1.111

Sir:

This communication is in response to the Office Action dated 24 March 2004.

Consideration of the remarks and entry of the amendments are respectfully requested.

Attorney Docket: 101216-19
USSN 09/975,520

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-14 are pending in the application. The claims have been rejected for allegedly being obvious over Penska in view of Franzke.

The prior rejection over Penska in view of Kurz was withdrawn in view of the aforementioned combination of references.

New dependent claims 15-18 have been added. These new claims are supported by the specification, e.g., page 14, original claim 9.

Preliminary Response to Examiner's Action

Applicants respectfully point out that although the previous rejection was withdrawn, the withdrawal is not in itself sufficient basis to ignore the discussion of the unexpected results presented in the previous response. "Objective evidence or secondary considerations such as unexpected results,...are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence." MPEP § 2141. Respectfully, it is indisputable that this evidence has not been evaluated.

In addition, there is virtually no difference between the rejection based on the combination of Penska/Kurz and that based on Penska/Franzke. Both Kurz and Franzke were cited for one reason only – to provide a basis of combining Penska's composition with mica/titanium pigment particles. In so doing, both Kurz and Franzke merely cite mica/titanium

Attorney Docket: 101216-19
USSN 09/975,520

as one of hundreds of different pigments disclosed in their respective specifications. This mere recitation of mica/titanium pigment particles is clearly insufficient for maintaining an obviousness rejection under § 103(a).

The Claimed Composition Has Unexpectedly Superior Properties

The MPEP expressly states that in overcoming a rejection under § 103(a), "rebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. Rebuttal evidence may consist of a showing that the claimed compound possesses unexpected properties." MPEP § 2141 (Emphasis added).

It is further relevant that the test for "unexpectedness" lies in demonstrating that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected. *In re Soni* 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

The Applicants tested the compositions shown in Example 1. Composition 1 was compared with Composition 1A (identical to Composition 1, but lacking the pigment, mica/TiO₂). See page 10. After shampooing the subjects' hair, either composition 1 or 1A was applied to the hair while wet or after drying. Professional stylists then assessed the treated hair in relation to the parameters listed in the table on page 11.

The results are clear – the addition of only mica/TiO₂ particles to the control composition, was sufficient to provide a hairstyling composition that demonstrates far superior hair management and styling when compared to the closest art, composition 1A.

As required by the rule in *Soni*, this new superior property was unexpected because mica/TiO₂ particles have not been disclosed in Penska or Kurz or Franzke, or any art of record, as possessing any hair-styling properties other than as a pigment. For example, it is indisputable the Franzke and Kurz merely disclose mica/titanium particles as one of hundreds or perhaps thousands of species of pigments. Nowhere in the references is it taught or suggested that mica/titanium by itself would impart superior styling properties to a haircare composition.

Attorney Docket: 101216-19
USSN 09/975,520

For this reason, the rejection should be withdrawn because persons in the art could not have reasonably predicted or expected that the claimed composition would provide superior styling properties.

The Unexpected Results are Commensurate in Scope With the Claims

"When considering whether proffered evidence is commensurate in scope with the claimed invention, Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition. See, e.g., *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Evidence that the compound or composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient to rebut a *prima facie* case of obviousness. *Id.* MPEP § 2144.08

In the present case, the claims are directed to a haircare composition demonstrating superior hairstyling properties. The tests described in the specification considered a spectrum of properties encompassing wet and dry hair. Accordingly, the superiority of the claimed composition is broadly established and is commensurate in scope with the claims' description of improved hairstyling properties.

CONCLUSION

It is respectfully requested that the Applicants' test results and the foregoing remarks be considered. It is believed that the test results overcome the rejection and thus, the rejection should be withdrawn.